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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,475	07/07/2003	Stephen H. Herrmann	22058-590DIV CON	5152
30623 7590 01/31/2007 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111			EXAMINER TUNGATURTHI, PARITHOSH K	
			ART UNIT 1643	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/31/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<p align="center"><b>Office Action Summary</b></p>	<b>Application No.</b> 10/614,475	<b>Applicant(s)</b> HERRMANN ET AL.	
	<b>Examiner</b> Parithosh K. Tungaturthi	<b>Art Unit</b> 1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 57-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The applicant has timely traversed the non-final rejection in the reply filed on 11/14/2006, and a response to the arguments is set forth.
2. Claims 65, 67 and 71 have been amended.
3. Claims 57-74 are under examination.
4. The text of those sections of Title 35 U.S.C. code not included in this office action can be found in a prior office action.
5. This office action consists of new grounds of rejection in view of amendments to the claims.

#### ***Rejections Withdrawn***

6. The rejection of claims 65 and 71 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of amendments to the claims.

The claims have been amended to replace "consisting essentially of" with "comprising".

#### ***Rejections Maintained***

7. The rejection of claims 57-74 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,730,296 (US '296) is maintained.

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The applicants argue that the instant claims require at least one chemokines polypeptide covalently attached to at least one heterologous polypeptide, wherein the heterologous polypeptide is an Fc polypeptide and that the Fc polypeptide required by the present claims is not disclosed in the claims of U.S. Patent 6, 730,296 (page of the remarks filed on 11/14/2006)

The above arguments have been carefully considered, but not found persuasive. It is agreed that the claims of U.S. Patent 6, 730,296 broadly recite "a heterologous polypeptide" without actually indicating what a heterologous polypeptide is within the claims. However, based on the knowledge of one of ordinary skill in the art, it would be reasonable to conclude that a heterologous polypeptide can mean any polypeptide and not limited to any one particular polypeptide. Hence, it is considered reasonable to consult the disclosure of the patent for an exact meaning, including the functional and structural limitations of "heterologous polypeptide" (which is an Fc polypeptide, column 2 lines 59-60, column 6 lines 24-25, column 9 lines 7-8, examples 1-3 and 6, in particular).

Further, the applicant is respectfully directed to chapter 800 of MPEP, wherein it states

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); and *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

The specification can be used as a dictionary to learn the meaning of a term in the patent claim. *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999)("[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the

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text of the patent makes clear that a word was used with a special meaning."); *Renishaw PLC v. Marposs Societa ' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings."). See also MPEP § 2111.01. Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. In *re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970).

Thus, one of ordinary skill in the art would have been motivated and would have had a reasonable expectation of success to have produced the claimed invention because claims 1-17 of U.S. Patent 6, 730,296 teach a composition comprising a chimeric polypeptide comprising at least one chemokine polypeptide covalently attached to at least one heterologous polypeptide. In addition, the disclosure defines a heterologous polypeptide as Fc polypeptide. Hence, it is reasonable to conclude that the disclosure of U.S. Patent 6, 730,296 satisfies the requirements to qualify as reading on the claimed invention.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

### ***New Grounds of Rejection***

8. Claims 67-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 67 is not clear for reciting "A polypeptide produced..... (a) growing a culture.....(a) SEQ ID NO:1 from ..... (b) purifying said .....", because:

(i) the claim includes two (a) steps.

(ii) the claim is confusing for reciting "(a) growing a culture.....wherein the chemokines polypeptide comprises (a) SEQ ID NO:1 from amino acid 22 to 328 and (b) purifying said polypeptide from the culture" in lines 6-9 of the claim. It is not clear as to what the applicant means by the above language. Does the applicant mean ""(a) growing a culture.....wherein the chemokine polypeptide comprises SEQ ID NO:1 from amino acid 22 to 328 and (b) purifying said polypeptide from the culture".

Appropriate correction is required.

### ***Conclusion***

9. No claims are allowed.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Parithosh K. Tungaturthi whose telephone number is 571-272-8789. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry R. Helms, Ph.D. can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,  
Parithosh K. Tungaturthi Ph.D.  
(571) 272-8789

  
SHEELA HUFF  
PRIMARY EXAMINER